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MAY 26 2004

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Robert GARFIELD et al.

Examiner: Herbert J. Lilling

Serial No.: 09/121,849

Group Art Unit: 1651

Filed: July 24, 1998

Title: TREATMENT OF PREECLAMPSIA TOXEMIA AND PRETERM LABOR  
WITH COMBINATION OF PROGESTATIONAL AGENT AND A NITRIC  
OXIDE SYNTHASE SUBSTRATE AND/OR DONOR

OFFICIAL

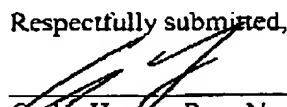
**PETITION TO WITHDRAW FROM ISSUE UNDER 37 CFR § 1.313(c)(2), AND  
REQUEST FOR CONTINUED EXAMINATION**Via Fax: 1-703-872-9306  
Mail Stop: Petitions  
Commissioner for Patents  
P O Box 1450  
Alexandria, VA 22313-1450

SIR:

Applicants request the withdrawal of the application from issue under MPEP § 1.313(c)(2) and the continued examination of the application. The attached statement for the Examiner's consideration is the submission required under 37 CFR § 1.114.

The Commissioner is hereby authorized to charge the petition fee of \$130 under § 1.17(h), and the RCE Fee of \$750 and any other fees associated with this petition or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
Csaba Hentler, Reg. No. 50,908  
Anthony J. Zelano, Reg. No. 27,969  
Attorney/Agents for Applicant(s)MILLEN, WHITE, ZELANO  
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Attorney Docket No. SCH-1237 D01

Date: May 26, 2004

UH pat R SCH-1237 D01 Pet to Withdraw from Issue.doc

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SUBMISSION FOR EXAMINER'S CONSIDERATION

Commissioner for Patents  
P O. Box 1450  
Alexandria, VA 22313-1450

Sir:

*In re Wertheim*, 646 F.2d 527, 209 USPQ 554 (CCPA 1981), governs the  
availability of the Harrison reference as prior art.

It, for example, the PTO wishes to utilize against an applicant a part of  
that patent disclosure found in an application filed earlier than the date of  
the application which became the patent, it must demonstrate that the  
earlier-filed application contains §§120/112 support for the invention  
claimed in the reference patent. For if a patent *could not* theoretically  
have issued the day the application was filed, it is not entitled to be used  
against another as "secret prior art,"

...  
only an application disclosing the patentable invention before the  
addition of new matter, which disclosure is carried over into the patent,  
can be relied upon to give a reference disclosure the benefit of its filing  
date for the purpose of supporting a §§102(e)/103 rejection.

See *Wertheim*, supra.

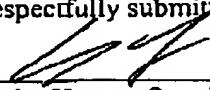
Applicants are not sure of what "guidelines" the Examiner is referring to

or what "legally available" means in the Reasons For Allowance given by the Examiner.

Presumably, the Examiner applied *Wertheim*, supra, and over the disclosure in Harrison's priority document (07/959,006), found the claims patentable on the basis of Applicants' arguments.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
Csaba Henter, Reg. No. 50,908  
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Attorney/Agent for Applicant(s)

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